

## REMARKS

Claims 1-35 and 37-52 are pending in this application. With this response, Claims 1, 3, 7, and 24 have been amended, as further explained below.

### **Objection To Claims 1, 3, 7, And 24**

Claim 1 is objected to for the reason that “the limitation ‘or and a polymer’ on line 5 on page 4 is incorrect and should be changed to --and a polymer--.” Applicants respectfully draw Examiner’s attention to the October 27, 2009 Response, in which “or a polymer” wording of Claim 1 was amended to read “~~or~~ **and** a polymer.” (emphasis added) Therefore, the pending Claim 1 reads “and a polymer” and not “or and a polymer.” Accordingly, withdrawal of this objection to Claim 1 is respectfully requested.

Claims 3 and 7 are objected to as having words “an hydroxyl group” instead of “a hydroxyl group.” Applicants hereby amend Claims 3 and 7 as suggested by the Examiner.

Claim 24 is objected to because, according to the Examiner. “[a]ll of the species of polyacyloxysilyl derivatives from lines 6 and on are improperly named.” Applicants hereby amend Claim 24.

All of the objections to Claims 1, 3, 7, and 24 are believed to have been resolved.

### **Rejection Of Claims 1-35 And 37-52 Under 35 U.S.C. § 112, Second Paragraph**

Claims 1-35 and 37-52 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because, according to the Examiner,  $R_4$  and  $R_5$  of Claim 1 may be  $-L'-SiR_1R_2-$  and  $-L'-(SiR_4R_5L')_n-SiR_1R_2-$  while  $R_4$  and  $R_5$  of formula (I) are monovalent.

Applicants respectfully traverse this rejection. It is respectfully submitted that the divalent nature of these possible substituents allows the polymer product to be branched and that

this claim feature is not indefinite to a person having ordinary skill in the art. This is supported by the definition of  $R_4$  and  $R_5$  in relation to formula (III) where corresponding  $-O-Z(O)-L-$  is  $-O-Z(O)-R_8$ . This gives the opportunity to the compounds of formula (III) to have reactive groups in positions  $R_4$  and  $R_5$ , which reactive groups can react with the polyacid of formula (II) to form a branched polymer of formula (I). Therefore, Applicants respectfully submit that Claim 1 is not indefinite to a person having ordinary skill in the art. Accordingly, withdrawal of this rejection of Claims 1-35 and 37-52 is respectfully requested.

Claims 1-35 and 37-52 are additionally rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because, according to the Examiner, Claim 1 limitation “with a proviso that  $R_1$ ,  $R_2$ ,  $R_4$  and  $R_5$  in formula (III) is  $-O-Z(O)-R_8$  when the equivalent group in formula (I) is  $-O-Z(O)-L-$ ” is confusing. The Examiner also stated that the term “the equivalent group” lacks proper antecedent basis.

Applicants respectfully traverse this rejection. Claim 1, as presently amended, recites “an equivalent group.” Accordingly, withdrawal of the lack of antecedent basis rejection is respectfully requested. Furthermore, a person having ordinary skill in the art would understand that the words “ $R_1$ ,  $R_2$ ,  $R_4$  and  $R_5$  in formula (III) is  $-O-Z(O)-R_8$  when an equivalent group in formula (I) is  $-O-Z(O)-L-$ ” have the meaning that  $R_1$ ,  $R_2$ ,  $R_4$  and  $R_5$  in formula (III) is  $-O-Z(O)-R_8$  when corresponding  $R_1$ ,  $R_2$ ,  $R_4$  or  $R_5$  in formula (I) is  $-O-Z(O)-L-$ . Therefore, Applicants respectfully submit that the meaning of Claim 1 is not indefinite to a person having ordinary skill in the art. Accordingly, withdrawal of this rejection of Claims 1-35 and 37-52 is respectfully requested.

Claims 1-35 and 37-52 are additionally rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because, according to the Examiner, “the requirement that Z may

be S-O does not make chemical sense” and “[c]learly, Z would have to be equal to Z=O (a sulfur oxygen double bond), so as to satisfy the valencies of sulfur and oxygen.” The Examiner pointed out that this limitation also appears in Claim 10.

Applicants respectfully traverse this rejection. Claim I, as pending, recites “wherein Z in formula (I), (II), (III), (IV), (V), and (VI) is independently C, POH, P or S=O.” Similarly, Claim 10, as pending, recites “wherein Z represents C, POH, P or S=O.” Both claims identify Z as optionally equal to S=O, not S-O. Accordingly, withdrawal of this rejection of Claims 1-35 and 37-52 is respectfully requested.

#### **Rejection Of Claims 37-39, 42-45, 51, And 52 Under 35 U.S.C. § 102(b)**

Claims 37-39, 42-45, 51 and 52 are rejected under 35 U.S.C. § 102(b) as anticipated by Kanno *et al.* (GB 2170814). The Examiner stated that “Kanno *et al.* explicitly teaches polysiloxane polyester compositions which have a plurality of repeat units which satisfy formula (I) of instant claim 1.”

Applicants respectfully traverse this rejection. The structure of formula (II) depicted on page 2 in Kanno *et al.* requires an “R” group to be present between what would be –L-Z(O)- group and –O-Si group in the formula (I) of Claim 1. The “R” group is defined in Kanno *et al.* as “a divalent organic radical.” Therefore, Kanno *et al.* does not disclose the compound of formula (I) of Claim I. Accordingly, withdrawal of this rejection of Claims 37-39, 42-45, 51 and 52 is respectfully requested.

#### **Potentially Allowable Subject Matter**

Applicants thank the Examiner for stating that Claims 1-35, 40-41, and 46-50 would be allowable if the 35 U.S.C. § 112 rejections are overcome. As discussed above, all of the 35

U.S.C. § 112 rejections are believed to be overcome and allowance of Claim 1-35, 40-41, and 46-50, as well as of the remainder of the pending claims, is respectfully requested.


It is believed that all of the Examiner's objections and rejections have been addressed and their withdrawal is respectfully requested. Applicants thank the Examiner for helpful amendment suggestions made in the February 8, 2010 Non-Final Office Action.

### CONCLUSION

Applicants respectfully submit that the application is now in proper form for examination and favorable consideration. The Examiner is invited to contact the undersigned attorney for Applicants to discuss any outstanding issues.

Respectfully submitted,

Date: May 5, 2010

  
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